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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/402,472	10/12/99	CELERIER	D 0143-0473-6-

QM22/1031

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EXAMINER	
JIMENEZ, M	
ART UNIT	**PAPER NUMBER**
3726	7

DATE MAILED: 10/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/402,472	Celerier et al.
Examiner	**Group Art Unit**
Marc Jimenez	3726

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-7 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-7** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- **Claim 1** recites the limitation "such as" in Line 4. This limitation is indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. *Ex parte Steigewald*, 131 USPQ 74.
- **Claims 4, 6, and 7** are indefinite because it is unclear what the scope of the invention encompasses. Applicant must clearly set forth whether the invention is a product or a process in the claims.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Enghauser (US Patent Number 1,906,953).

Enghauser teaches a pipe element (10 Fig. 6) having a housing (19 Fig. 3). The intended use of the pipe element as recited in the preamble of the claim lends no patentable weight to the device since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Also, with respect to the limitation "in which a measuring transducer such as an oxygen sensor can be mounted", it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Furthermore, the particular way the device is formed is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

5. **Claims 1-3 and 5** are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Applicant's Admitted Prior Art [AAPA] (Page 1 to Page 2).

[AAPA] teaches an exhaust device for internal combustion engines having a pipe element (Page 2, Line 1) having a housing (Page 1, Line 26). The wall is between 1 and 3 mm thick (Page 2, Line 4).

6. **Claims 1, 4, 6, and 7** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Heinrichs (DE 42 24 131 A1).

Heinrichs teaches the invention as claimed.

Claim Rejections - 35 U.S.C. § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 2, 3, and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Enghauser.

With respect to **Claim 2**, Enghauser teaches the invention cited above with the exception of the pipe element being provided with a wall thickness of 1 and 3 mm.

It would have been an obvious matter of design choice to have made the pipe element of Enghauser with a wall thickness between 1 and 3 mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

With respect to **Claims 3 and 5**, Enghauser teaches the invention cited above with the exception of making the wall of stainless metal alloy. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have made the wall of Enghauser out of stainless metal alloy, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 406. See also *Ballas Liquidating Co. V. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

9. **Claims 1-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Enghauser in view of Olson (US Patent Number 5,984,138).

Enghauser teaches the invention cited above with the exception of using an ogival mandrel.

Olson teaches a flow drilling operation using an ogival mandrel (40 Fig. 4).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Enghauser with an ogival mandrel, in light of the teachings of Olson, in order to flow drill an accurately shaped hole.

Also, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have substituted the mandrel of Enghauser with the one of Olson since such elements are equivalent structures known in the flow drilling art. Therefore, because these elements were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the flow drill of Enghauser with the ogival mandrel of Olson.

10. **Claims 1-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over [AAPA] in view of Olson.

[AAPA] teaches the invention cited above with the exception of flow drilling.

Olson teaches the invention cited above including flow drilling.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of [AAPA] with flow drilling, in light of the teachings of Olson, in order to form a one piece housing.

Contact Information

11. Official documents related to the instant application may be submitted to the Technology Center 3700 mail center by facsimile at (703) 305-3579/3580. Should Applicant desire to submit

a DRAFT response to the Examiner by facsimile transmission, then Applicant should contact the

Examiner at the number below for instructions concerning the transmission of DRAFT documents. Applicant is reminded to clearly mark any facsimile transmissions as "DRAFT" if it is not to be considered as an official response.

12. Any inquiry concerning this communication should be directed to Examiner Marc Jimenez at telephone number (703) 306-5965.

MJ

October 26, 2000

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